

REMARKS

Claims 1-5 and 7-9 are pending.

The support for the amendment "into a desired curved shape by applying force with a hand or fingers" is found from page 12, line 26, to page 13, line 1, of the specification.

The support for the amendment "said curved shape is maintained in the absence of external force" is found on page 3, lines 5-8 of the specification stating: "[i]t is an object of the present invention to provide a medical handpiece which allows the operator to adjust the sheath to an optimal angle for cutting"; page 10, lines 13-14 stating: "the curved shape of the tube portion 3c is maintained for the surgery"; page 11, lines 4-9 stating: "[w]hen the operator has difficulties in observing the tip of the tool 1, he can withdraw the handpiece 10 from the patient, malleably deform the tube portion 3c to properly adjust the curvature of the tube portion 3c, and re-insert the handpiece 10 into the nasal cavity for cutting the treatment site"; page 13, lines 1-3 stating: "[w]ith such a desirably curved tube portion, an operator may give treatment using the handpiece".

From these descriptions, it is apparent that the tube portion of the sheath is deformable into a desired curved shape and the curved shape is maintained for the operation in the absence of external force. If the tube portion of the sheath is merely flexible, the tube portion may return to the original straight shape or the desired curved shape cannot be maintained, before re-insertion of the handpiece into the nasal cavity.

Applicant has withdrawn Claim 8 from consideration, but requests rejoinder of such claim upon an indication that Claim 1 is allowable (see MPEP 821.04(b)).

Claims 1-3, 5 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Simpson et al. (USP 5,047,040). Applicant respectfully traverses this rejection.

To anticipate a claim, a reference must teach every element of the claim (MPEP 2131).

Simpson et al. teach a catheter having a flexible tubular member (102), which is alleged to correspond to the tubular sheath of the present invention. The Examiner argues in Response to Arguments that the device of Simpson et al. is flexible and is therefore malleable.

Amended claim 1 clearly defines that the elongate tube portion of the sheath is malleable and deformable into a desired curved shape by applying force with a hand or fingers, and said

curved shape is maintained in the absence of external force. With this property of the tube portion, the sheath of the present invention may be adjusted advantageously to an optimal angle before it is inserted, for example, into the nasal cavity of a patient for cutting the treatment site.

On the other hand, Simpson et al. merely teach that the flexible tubular member (102) is "flexible", and there is no disclosure in this reference that the tubular member (102) is "malleable and deformable into a desired curved shape by applying force with a hand or fingers, and said curved shape is maintained in the absence of external force". Such a "flexible" tubular member (102) may return to the original straight shape and the desired curved shape would not be maintained before insertion of the handpiece into the nasal cavity.

Thus Simpson et al. do not even suggest the inventive feature of the present invention.

Further in Response to Arguments, the Examiner alleges that the limitation "to be chucked in a handpiece body" is a functional limitation, and the handpiece body is not positively claimed.

The Examiner's attention is drawn to claim 1, wherein the handpiece body is positively claimed as the fourth element of the handpiece. Further, the recitation is amended to "chucked in the handpiece body".

Thus the limitation is not functional, and clearly distinguishes the present invention from the device of Simpson et al., which is a catheter and will not be chucked in a handpiece body.

Therefore, the present invention as set forth in claims 1-3, 5 and 9 is not anticipated by Simpson et al.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. in view of Brown.

Claim 4 depends from claim 1, of which subject matter is not taught or suggested either in Simpson et al. or Brown. Thus, claim 4 is not obvious over Simpson et al. in view of Brown.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al.

Claim 7 depends from claim 1, of which subject matter is not taught or suggested in Simpson et al. Since the claimed property is not disclosed in Simpson et al., there is no motivation suggested therein for determining the optimum value of the property. Therefore, claim 7 is not obvious over Simpson et al.

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